

REMARKS

Claims 1-19 are pending in this application.

Claim Rejections

In the office action dated May 9, 2002, the examiner rejected claims 1-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,304,853. The examiner also rejected claims 15-19 under 35 U.S.C. § 112, second paragraph, as indefinite, stating that "The claims failed to particularly point out and distinctly claim the automation steps necessary to carry out the automated method set forth in the preamble. (The method steps do not perform the automated method as stated in the preamble)." In addition, the examiner rejected claims 1-15, and 18-19 as obvious over Aggarwal, U.S. Patent No. 6,239,867, in view of Newman et al., "A Multimedia Solution to Productivity Gridlock: A Re-Engineered Jewelry Appraisal System at Zale Corporation," MIS Quarterly, Vol. 18, No. 1, March, 1994. The examiner rejected claims 16 and 17 as obvious over Aggarwal in view of Newman as applied to claim 15, and further in view of "the Jewelry Judge."

Claim Amendments

Claims 1, 8, and 15 have been amended to remove the phrase "consumer usable" in the preamble, and the word "consumer," that appeared before the phrase "evaluation report" in those claims, and have also been amended to insert the word "system" directly before the last occurrence of the word "user." These amendments are intended to clarify that the evaluation report need not be a consumer evaluation port in accordance with the invention, and to clarify that the evaluation report is communicated to the system user. In addition, claim 15 has been amended to recite that the method is computerized rather than the phrase "fully automated" which the examiner found to be objectionable. Claims 1 and 8 have also been amended to remove the phrases "for receiving," "for computing," and "for communicating," in order to make it absolutely clear that there is no intention to invoke 35

U.S.C. § 112, paragraph six, in connection with these claims. Claim 18 has been amended to correct a typographical error therein. It is submitted that none of these claim amendments have narrowed the scope of the claims.

Independent Claims

Claim 1, as amended, is directed to a fully automated gemstone evaluation system for which the presence of the actual gemstone is not required. The system includes an input device for receiving predetermined gemstone data supplied by a system user. The predetermined gemstone data is the type found on a gemstone laboratory grading certificate including cut type, weight, color clarity, and cut proportions. The data for cut proportions includes an objective measurable value for at least one of depth percentage, table percentage, girdle thickness, crown height, crown angles, pavilion depth, pavilion angles, culet amount, and type of finish. The system further includes a processing device for computing a price estimate for use in an evaluation report, based on the gemstone data received. The system also includes an output device for communicating the evaluation report to the system user.

Independent claim 8, as amended, is directed to a fully automated gemstone evaluation system for which the presence of the actual gemstone is not required. The system includes an input device adapted to receive predetermined gemstone data descriptive of the physical characteristics of the gemstone to be evaluated, supplied by a system user, of the type found on a gemstone laboratory grading certificate including cut type, weight, color, clarity, and cut proportions. The system further includes a processing device adapted to compute a fair market pricing estimate for use in an evaluation report, based upon the gemstone data received. The system further includes an output device adapted to communicate the evaluation report to the system user.

Independent claim 15, as amended, is directed to a computerized method of producing a gemstone evaluation report. The method does not require the presence of the actual gemstone. The method includes the steps of: receiving predetermined data describing a

gemstone, descriptive of the physical characteristics of the gemstone to be evaluated, supplied by a system user, of the type found on a laboratory grading certificate including cut type, weight, color, clarity, and cut proportions; computing a fair market pricing estimate for the gemstone, based on the received data describing the gemstone; generating an evaluation report including the pricing estimate; and communicating the evaluation report to the user.

Double Patenting Rejection

The applicant respectfully traverses the obviousness-type double patenting rejection, in view of a terminal disclaimer filed concurrently herewith. Accordingly, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

Indefiniteness Rejections

Claim 15 has been amended to omit the phrase "fully automated" that the examiner found to be inconsistent with the body of the claim. The word "computerized" has been inserted in the preamble of the claim, which is consistent with the body of the claim (i.e., the "computing" step). Applicant notes that this amendment to claim 15 does not narrow the scope of the claim. Reconsideration and withdrawal of the indefiniteness rejection of claims 15-19 is respectfully requested.

Obviousness Rejections

Applicant respectfully traverses the rejection of claims 1-15 and 18-19 as unpatentable under 35 U.S.C. § 103(a) over Aggarwal in view of Newman et al.

Aggarwal discloses a method and apparatus for grading gemstones using spectral analysis, requiring the presence of the actual gemstone being graded. Newman et al. discloses a jewelry appraisal system that may be used by gemologists when appraising pieces of jewelry. The system disclosed in Newman et al. includes the capability of retrieving an "adoption sheet" file that includes "the type and weight of the mounting metal, the cut, color and clarity of the diamond, etc. -- all of the information that a gemologist must ascertain

during an appraisal." The adoption sheet data is compared to the item of jewelry by the gemologist, again requiring the actual presence of the gemstone being evaluated.

Furthermore, neither Aggarwal nor Newman et al. discloses or suggests the use of cut proportions, as also recited in claims 1-15 and 18-19.

With regard to claim 3, neither Aggarwal nor Newman discloses or suggests that it would be desirable or even possible to provide a separate price estimate for each of a plurality of different types of retail outlets, as recited in claim 3. With regard to claim 7, neither Aggarwal nor Newman discloses or suggests that it would be desirable or even possible for the respective systems and methods disclosed therein to be used by a consumer.

Applicant respectfully traverses the rejection of claims 16-17 as obvious over Aggarwal in view of Newman et al. as applied to claim 15, and further in view of the Jewelry Judge.

The Jewelry Judge concerns a semi-automated system for appraisers by which a generalized "high average and low price/carat" price is obtained for a particular gemstone which the appraiser manually and personally makes adjustments to, using his or her personal judgment. Jewelry Judge does not disclose or suggest the use of cut parameters, instead using relatively vague industry standard cut grades, such as "Medium Good Class 2B," which represents a range of cut factors. Jewelry Judge does not disclose or suggest any input of individual cut parameters such as depth percentage, table percentage, or girdle thickness. Accordingly, Jewelry Judge does not make up for the deficiencies of the disclosures of Aggarwal and Newman et al. in this regard. Furthermore, the applicant respectfully traverses the obviousness rejections as failing to make out a *prima facie* case of obviousness.

According to 35 U.S.C. §103(a), a claimed invention is unpatentable due to obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." In order to determine obviousness four factual inquiries must be

made concerning: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the claimed invention and the prior art; and 4) secondary considerations of nonobviousness.

Without waiving any rights to rebut any of the other factual inquiries, Applicant respectfully submits that the rejections set forth in the Office Action fail to make clear and particular findings as to why the cited patents are within the appropriate scope of the prior art in determining the obviousness of the pending claims in view of the cited combinations of Aggarwal in view of Newman et al. and/or Jewelry Judge.

In order to prevent a hindsight-based obviousness analysis, the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. The reasons, suggestion or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem. While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be clear and particular. (Citations omitted).

Applicant respectfully submits that the rejections as stated in the Office Action fail to establish any reason, suggestion, or motivation present in the above-noted patents or any other prior art, in the knowledge of those of ordinary skill in the art, or in the problem solved by Applicant's claimed invention which clearly and particularly would lead one of ordinary skill in the art to arrive at Applicants' claimed invention by taking the Aggarwal patent disclosure's system and modifying it by incorporating features disclosed in Newman et al. and/or Jewelry Judge.

This selection of various elements from the cited references, is an impermissible exercise in reconstructing the claimed invention from selected pieces of prior art without a clear and particular showing of any reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references to arrive at Applicant's claimed invention.

Because none of the cited art, taken singly or in combination with other prior art references, discloses or suggests all of the elements of the claims at issue as noted above, and further because such art fails to disclose or suggest that it would be desirable or even possible to combine features of one with another to arrive with the claimed combination of elements, it follows that a *prima facie* of obviousness has not been established. See, In re Sernaker, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and ex parte Clapp, 227 U.S.P.Q. 973, 973 (VD. Pat. App. 1985).

It should also be noted that the applicant does not concede that the applied references and even some of the references cited as pertinent to the applicant's disclosure actually qualify as prior art to his application. For example, "the Jewelry Judge" claims copyright "1985-1999." There is no delineation in the reference as to what portions of the discussion had not been published until 1998 or 1999, and it is entirely possible that such portions considered to be pertinent by the examiner were published after the filing date of this application on September 21, 1998. It is noted that the examiner appears to be taking the position that the Jewelry Judge was published at least as early as April 1995, citing "The Real Computer Payoff: Part 3," which references software called "The %Jewelry%Judge%." However the examiner has not made any showing that this reference to software from a company called "The %Jewelry Judge%" has any relation to the "Jewelry Judge software shown in the printout dated "Copyright 1985-1999." In addition, with regard to Aggarwal, the applicant has not taken the necessary steps to confirm that Aggarwal is prior art to this application, as the applicant has not reviewed the provisional application on which Aggarwal claims priority. However, should the examiner persist in the rejections based on prior art

such as Aggarwal and Jewelry Judge, the applicant reserves the right to swear behind such references, if appropriate.

Conclusion

In view of the amendments and remarks presented herein, it is respectfully submitted that each of the outstanding rejections have been either demonstrated as improper or overcome. Accordingly, reconsideration of the application and allowance of the claims are earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 1, 8, 15, and 18 as follows:

1. (Amended) A [consumer usable] fully automated gemstone evaluation system for which the presence of the actual gemstone is not required, comprising:

an input device [for receiving] adapted to receive predetermined gemstone data supplied by a system user of the type found on a gemstone laboratory grading certificate including cut type, weight, color, clarity, and cut proportions wherein the data for cut proportions includes an objective measurable value for at least one of depth percentage, table percentage, girdle thickness, crown height, crown angles, pavilion depth, pavilion angles, culet amount, and type of finish;

a processing device [for computing] adapted to compute a pricing estimate for use in [a consumer] an evaluation report, based upon the gemstone data received; and

an output device [for communicating] adapted to communicate the evaluation report to the system user.

8. (Amended) A [consumer usable] fully automated gemstone evaluation system for which the presence of the actual gemstone is not required, comprising:

an input device [for receiving] adapted to receive predetermined gemstone data descriptive of the physical characteristics of the gemstone to be evaluated, supplied by a system user, of the type found on a gemstone laboratory grading certificate including cut type, weight, color, clarity, and cut proportions;

a processing device [for computing] adapted to compute a fair market pricing estimate for use in [a consumer] an evaluation report, based upon the gemstone data received; and

an output device [for communicating] adapted to communicate the evaluation report to the system user.

15. (Amended) A [fully automated] computerized method [for] of producing a gemstone evaluation report, [said method being consumer usable and] without the presence of the actual gemstone being required, said method comprising the steps of:

receiving predetermined data describing a gemstone, descriptive of the physical characteristics of the gemstone to be evaluated, supplied by a system user, of the type found on a gemstone laboratory grading certificate including cut type, weight, color, clarity, and cut proportions;

computing a fair market pricing estimate for the gemstone; based on the received data describing the gemstone;

generating [a consumer] an evaluation report including the pricing estimate; and
communicating the evaluation report to the system user.

18. (Amended) The method of claim 15, wherein said step of [the]
communicating the evaluation report to the user includes at least one of the steps of:

printing the evaluation report on a printer; and

displaying the evaluation report on a display screen.